

REMARKS

By the present amendment, claims 10 and 30 have been amended to provide antecedent basis for the optical material and the portions with and without ink information and to separate the claim in paragraphs. In particular, the expression “having an ink information for identification” has been replaced by “comprising a portion comprising an ink information for identification and another portion without the ink information.”

It is submitted that the amendments do not raise any new issues and their entry is respectfully requested.

Claims 10-51 are pending in the present application. Claims 10 and 30 are the only independent claims.

In the Office Action, claims 10-11 are rejected under 35 U.S.C. 112, second paragraph, as indefinite. It is alleged in the Office Action that the terms “the optical material” and “said portion without ink information” lack antecedent basis.

As a preliminary, Applicants request withdrawal of the finality of the Office Action, and a new non-final Office Action. This rejection is made for the first time in a final Office Action, and the rejection is not caused by the amendments to the claims because the language which is now objected to was already present in the original claims. It is submitted that making the rejection for the first time in a final Office Action deprives the Applicants of a fair opportunity to respond. Accordingly, it is submitted that the finality of this Office Action should be withdrawn, and a new, non-final Office Action should be sent.

Further, Applicants submit that the lack of antecedent basis has been addressed without raising new issues by the present amendments to provide antecedent basis for the optical material

and the portions with and without ink information. Accordingly, it is submitted that the amendments should be entered and the rejection should be withdrawn.

Next, in the Office Action, claims 10-11, 13-21, 25-30, and 32-51 are again rejected under 35 U.S.C. 103(a) as obvious over US 6,063,174 to Shirota et al. ("Shirota") in view of US 6,654,085 to Koike et al. ("Koike"), claims 22-24 and 41-43 are rejected under 35 U.S.C. 103(a) as obvious over Shirota in view of Koike and further in view of US 4,812,034 to Mochizuki et al. ("Mochizuki"), and claims 12 and 31 are rejected under 35 U.S.C. 103(a) as obvious over Shirota in view of Koike and further in view of US 5,856,048 to Tahara et al. ("Tahara").

It is alleged in the Office Action that it would have been obvious "to modify the multilayer optical element of Shirota to include an easy-releasing protective member because Koike teaches that such a easy-releasing protective member is required for transfer purposes like to a liquid crystal display for instance" (Office Action, end of full paragraph of page 4), and that the focus on the protective films 34 and 54 of Koike in the last response was insufficient because Koike also discloses easy-release substrates 3.

Reconsideration and withdrawal of the rejections is respectfully requested. Shirota fails to teach or suggest a releasable substrate 1 or protective film 10, and Koike fails to provide a suggestion or motivation to modify Shirota.

Specifically, in Shirota, substrate 1 with an ink layer 9 forms a color filter, and a protective layer 10 may be formed on the color filter (see Shirota at col. 11, line 18). However, the protective layer 10 is not intended to be removable, but to serve as a protective layer in a display, as clearly shown in Fig. 2 of Shirota.

Further, Koike discloses a substrate 3 which is removed from a light scattering layer 2

before adhering the layer 2 to another optical member, such as a glass substrate of a liquid crystal cell. However, Koike fails to provide a suggestion or motivation to provide an easy-releasable substrate in the case where its substrate 3 is intended to remain in an optical construction. In particular, Koike distinguishes “non-peelable substrates 3” (col. 6, lines 18-20) which are intended to remain in the optical construction and may need further treatment to enhance their optical properties, from “peelable substrates 3” (col. 6, lines 28-30) which are intended to be peeled from the light scattering layer 2. As a result, a person of ordinary skill in the art would find no motivation in Koike to modify the protective layer 10 of Shirota in the form of a “peelable” layer, as the protective layer 10 is not intended to be removed but remains as a protective layer in the optical construction of Shirota.

In addition, even if, *arguendo*, a person of ordinary skill in the art attempted to combine Shirota with Koike, this would not result in the presently claimed invention because that person would provide the easy-release property on a side of the protective layer 10 of Shirota facing the color filter layer 9. In other words, the protective layer 10, even if modified to be provided with an easy-release property, would be removable whereas the colored ink of the color filter layer 9 would remain permanently in the display of Shirota. As a result, the protective layer 10, even provided with an easy-release property, would not form an easy-releasing protective member comprising a portion comprising an ink information for identification, as recited in present claims 10 and 30.

Similarly, if, *arguendo*, a person of ordinary skill in the art attempted to incorporate the light scattering film 2 or substrates 3 of Koike into the construction of Shirota, any “peelable” substrate of Koike used in Shirota would not have any ink information for identification.

In contrast, the present inventors have found that, by providing an easy-releasing protective member comprising a portion comprising an ink information for identification, said easy-releasing protective member being provided on at least one side of front side and back side on an optical material of the optical member, as recited in present claims 10 and 30, it is possible to provide easy temporary identification of optical members during a manufacturing process. This feature of the presently claimed invention is not taught or suggested in any of the cited references. Therefore, the present claims are not obvious over the cited references taken alone or in any combination.

In view of the above, it is submitted that the rejections should be withdrawn.

In conclusion, the invention as presently claimed is patentable. It is believed that the claims are in allowable condition and a notice to that effect is earnestly requested.

In the event there is, in the Examiner's opinion, any outstanding issue and such issue may be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

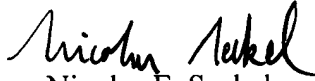
Serial Number: 10/056,973

Group Art Unit: 1774

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of the response period. Please charge the fee for such extension and any other fees which may be required to our Deposit Account No. 50-2866.

Respectfully submitted,

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